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| 09/584,182 | 05/31/2000 | David Suda | 192403US55X | 4191 |
| 22850 | 7590 | 05/17/2004 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. | | | HARMON, CHRISTOPHER R | |
| 1940 DUKE STREET | | | ART UNIT | |
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3721

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 051304

Application Number: 09/584,182
Filing Date: May 31, 2000
Appellant(s): SUDA ET AL.

Christopher D. Ward
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/05/04.

(1) *Real Party in Interest*

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because no reasons are provided as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|------------|-----------------|--------|
| GB 448,519 | Robinson et al. | 6-1936 |
| 5,020,302 | Buchman et al. | 6-1991 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (GB 448,519) in view of Buchman et al. (US 5,020,302).

Robinson et al. disclose a machine for rolling up flexible articles and describes a method for its use. An article is inserted into receptacle 1 via a hollow cylindrical tube section having first and second openings; see figure 1. The first opening 5 is a cone with a flared section connected to the second narrower opening. The receptacle 1 is positioned over the second narrow opening of the tube and the rolled article is inserted through first flared opening 5, through second narrow opening, and into receptacle 1 in a predetermined orientation. The tube section is mounted stationary structure 2.

Robinson et al. do not directly disclose rotating the article during the insertion process into either the flared section or the tubular section. However, Buchman et al. directly teaches rotating a rolled item in a roll inserter while rotating the rolled item in a

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direction opposite the direction of the roll from the center spiraling outward during an inserting operation; see figure 1, column 3, lines 57-60. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the rotating of a rolled product as taught by Buchman et al. in the invention of Robinson et al. in order to assist in the insertion process.

(11) Response to Argument

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art is fully capable of rotating a rolled item while inserting it into a tubular structure. In order to reduce friction or tail interference, it is well known to rotate a rolled product when inserting into a confining structure such as a tube or container. Rolled printed matter such as posters, architectural drawings, Christmas wrapping paper, etc. more easily slide into cardboard tubes etc. for storage or travel and would have been obvious to one of ordinary skill in the art to perform this method. More specifically, Buchman et al. teach rotating the rolled product while inserting to avoid tail interference in a confining structure "only slightly larger than the outside diameter of the roll" (see column 2, lines 5-10).


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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).


Note also that cited references to Chapuis and Holt teach similar methods however the tubular structure seems only to be tapered in shape.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Chris Harmon
May 13, 2004

Conferees
Scott Smith 
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